

**REMARKS**

**I. Status of the Application**

Claims 1-22 were filed in the original Application. In the Office Action, the Examiner:

(a) acknowledged the election by Applicant of Invention 1 (claims 1-11), requesting affirmation of the acknowledgement by the Applicant;

(b) rejected claims 3-7, 9 and 10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention;

(c) rejected claims 1 and 11 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,834,081 to Fanti ("Fanti");

(d) rejected claims 2-7, 9 and 10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fanti in view of U.S. Patent No. 4,361,626 to Boba et al. ("Boba et al."); and

(e) stated that claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, as set forth in the Office Action and if it includes all of the limitations of the base claim and any intervening claims.

In this response, Applicant respectfully amends claims 3 and 9, and withdraws claims 12-22, from further consideration during the prosecution of this Application. Claims 1, 2, 4-8, and 10-11 also remain in the Application but are not amended. Applicant respectfully submits that the foregoing amendments and following remarks incorporated herein traverse or overcome the Examiner's rejections of and objections to the Application.

**II. No New Matter Is Introduced by Way of Amendment**

Applicant respectfully submits that no new matter has been added by amending claims 3 and 9 and withdrawing claims 12-22. Specifically, the amendments to claims 3 and 9 were made to properly cause claims 3 and 9 to depend from dependent claim 2. Applicant respectfully submits that the amendments are supported by the originally filed Application and do not add new matter. Accordingly, Applicant request that the amendments be entered and that the Application proceed to allowance.

**III. Applicant Elects Invention I (Claims 1-11) for Consideration**

During a telephone conversation between the Examiner and Rachel St. Peter on August 16, 2005, a provisional election was made to prosecute Invention I (claims 1-11). Applicant hereby affirms that it elects, Invention I and claims 1-11 directed thereto.

**IV. The Rejection of Claims 3-7, 9 and 10 under 35 U.S.C. § 112, Second Paragraph, as Allegedly Being Indefinite Should be Withdrawn**

The Applicant respectfully submits that the rejection of claims 3-7, 9 and 10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, should be withdrawn in view of the amendments to claims 3 and 9. Claims 3 and 9 have been amended to now each depend from claim 2 instead of claim 1, thus pointing out and distinctly claiming the subject matter in claim 2, namely the "thermally labile polymeric coupling agent." Claims 4-7 and 10 each depend from and incorporate all the limitations of claim 3, as amended.

Accordingly, and in view of the aforementioned amendments, Applicant respectfully submits that the rejection of claims 3-7, 9 and 10 under 35 U.S.C. § 112 is overcome and should be withdrawn.

**V. The Rejection of Claims 1 and 11 under 35 U.S.C. § 102(b) as Allegedly Being Anticipated by Fanti is Overcome**

In the Office Action, the Examiner rejected claims 1 and 11 under 35 U.S.C. § 102(b) as allegedly being anticipated by Fanti. Applicant respectfully submits that the rejection of claims 1 and 11 is overcome because claims 1 and 11 are patentably distinguishable over Fanti. A rejection under §102(b) can be overcome by "persuasively arguing that the claims are patentably distinguishable from the prior art." MPEP § 706.02(b).

A prior art patent, publication, or event is for the same "invention," as that word is used in § 102, and therefore anticipating, if the prior art patent, publication or event discloses each and every limitation found in the claims, either expressly or inherently. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Each claim limitation must be found in a single prior art reference; references cannot be combined under § 102. *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on § 102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983). Where a reference is alleged to inherently disclose a claim element, the missing element must necessarily be present in the cited reference

and that it be so recognized by those of skill in the art. It is not enough that the missing element is possibly or probably present. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

### The Invention of Fanti

Fanti teaches a plastics floor tile made of a plurality of discrete plastic pieces which are assembled together along mutually abutting edges formed between the backing layers of the discrete plastic pieces (col. 1, lines 39-47). The backing layers of Fanti are the lowermost surfaces thereof (fig. 2).

### Applicant's Invention

Applicant's present application discloses "a joining film to join the discrete pieces together to form a unitary floor covering." (Application, page 2, lines 14-15). Such joining film may be "secured to the lower surface of each discrete plastics component and spanning at least the edges of neighboring discrete components." (Application, page 2, lines 19-21). Further, and as is shown in Applicant's figure 3, joining film 14 spans more than one discrete plastics component. In summary, the present application provides for a joining film that "secur[es] said components together relative to one another." (Application, claim 1).

Fanti Does Not Disclose, Teach, Or Suggest a Joining Film

The Examiner alleges that the step of Fanti discloses "securing...components together relative to one another by the application of at least one portion of a joining film 17" (Office Action, page 4, lines 5 and 6). Applicant respectfully submits that while Fanti discloses reference number 17 as a "backing layer," it does not disclose, teach, or suggest a joining film as claimed in the present application.

Applicant respectfully submits that Fanti does not disclose, teach, or suggest a joining film or the step of "securing...components together relative to one another by the application of at least one portion of a joining film" as required in Applicant's claim 1. Fanti does not disclose, teach, or suggest an additional joining film, discrete from the backing layer, and applied to the lower surface, that, when applied "spans at least the neighboring edges of adjacent...components" as required in claim 1. The Examiner has implied that the application layer 17 of Fanti is equivalent to application of the joining layer of the present application. However, reference number 17 in Fanti is clearly disclosed as a backing layer (column 2, line 59) affixed to each of pieces 10, 11, and 12, as are PVC film 15 and PVC background layer 16. Each of layers 15, 16, and 17 are applied individually to each of pieces 15, 16, and 17 and the pieces "are shaped relative to each other and assembled together to abut edge to edge in lower regions of the pieces and form a recess above each mutually abutting edge of each abutting pieces in upper regions of the pieces..." (Column 1, lines 41-44) (*emphasis added*) (*see also* Fig. 2, column 3, lines 19-20, and column 4, line 28, for affirmation of the abutting edges). The requirement of abutting edges of the lower region (layers 15, 16, and 17) of the pieces of Fanti

means that Fanti does not disclose, teach, or suggest securing to the pieces of a joining film so that the joining film spans at least the neighboring edges of adjacent pieces as is required in Applicant's claim 1.

Applicant's Claim 1 is Not Anticipated by Fanti

Accordingly, Fanti does not disclose each and every element of the claims of the present invention, namely the step of "securing...components to together...by the application of at least one portion of a joining film...so that the joining film spans at least the neighboring edges of adjacent...components." Therefore, Applicant respectfully submits that claim 1 is patentable, and the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Fanti is traversed.

Applicant's Claim 11 is Not Anticipated by Fanti

Claim 11 depends from and includes all the limitations of claim 1, and, as discussed above claim 1 is believed to be patentable over Fanti. Therefore, it is respectfully submitted that claim 11 is also allowable, and Applicant respectfully requests that the rejection of claim 11 as being anticipated by Fanti is also traversed.

**VI. The Rejection of Claims 2-7, 9 and 10 under 35 U.S.C. § 103(a) as Allegedly Being Obvious Over Fanti in View of Boba et al. is Overcome**

In the Office Action, the Examiner rejected claims 2-7, 9 and 10 under 35 U.S.C. § 102(b) as allegedly being obvious over Fanti in view of Boba et al. Applicant respectfully

submits that the rejection of claims 2-7, 9 and 10 is overcome because neither Fanti nor Boba et al. disclose, teach or suggest all the limitations of claims 2-7, 9 and 10.

Three factual determinations are required when evaluating whether or not a claimed invention is to be considered as obvious over the prior art: (i) the scope and content of the prior art; (ii) the differences between the prior art and the claims at issue; and (iii) the level of ordinary skill in the pertinent art. *Graham v. John Deere*, 383 U.S. 1, 17 (1966). As such, three criteria must be met to establish a *prima facie* case of obviousness: (i) there must be some suggestion or motivation to combine the teachings of two or more prior art references; (ii) there must be a reasonable expectation of success; and (iii) "all of the claim limitations must be taught or suggested by the prior art." MPEP §§ 2143 and 2143.03 (citing *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974)).

Applicant respectfully submits that Fanti and Boba et al. together do not disclose, teach, or suggest all of the claim limitations noted in claims 2-7, 9 and 10 of the present application. As previously discussed in IV above, Fanti does not disclose, teach, or suggest the step of securing a joining layer as is taught by and claimed in the present application. The Examiner alleges that Boba et al. "discloses a method for forming a flooring material, said method comprising bonding a polyvinyl chloride layer (column 3, lines 40-50) to a coating of a polymeric coupling agent, wherein said coupling agent is polyurethane (column 2, lines 54-68), and wherein during the bonding process the material is subjected to heat and pressure such that said polyurethane coating reacts and cross-links with the PVC layer (column 6, lines 52-68)."

(Office Action, pages 4-5). Examiner further discusses what is alleged to occur after the aforementioned reaction occurs.

Applicant's Claim 2 is Not Obvious under Fanti in View of Boba et al.

Applicant respectfully submits that while Boba et al. discloses methods for bonding synthetic polymeric materials, it also does not disclose, teach, or suggest the step of securing of a joining layer as is claimed in Applicant's claim 1. As Applicant's claim 2 depends from and includes all of the limitations of claim 1, Applicant respectfully submits that claim 2 also includes the step of a joining layer to the lower surface of assembled components so that the joining of film spans neighboring edges of adjacent components. Additionally, Boba et al. does not disclose, teach, or suggest the connection of a "plurality of discrete plastics components" to form a unitary tile as taught by the present application. As such, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness, as all of the claim limitations in claim 2 must be taught or suggested by the prior art for claim 2 to be rendered obvious. MPEP §§ 2143 and 2143.03 (citing *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974)). As such, Applicant respectfully submits that the Examiner's rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over Fanti in view of Boba et al. is traversed.

Applicant's Claims 3-7, 9 and 10 are Not Obvious over Fanti in View of Boba et al.

In addition to the foregoing, claims 3-7, 9 and 10 ultimately depend from and include all of the limitations of claim 2. As Applicant has shown that claim 2 is not obvious under 35



U.S.C. §103(a), Applicant respectfully submits that claims 3-7, 9 and 10 are also not obvious as depending from allowable claim 2, and as such, Applicant respectfully submits that the Examiner's rejection of claims 3-7, 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over Fanti in view of Boba et al. is traversed.

Claims 2-7, 9 and 10 are Patentable Notwithstanding Examiner's 35 U.S.C. § 103(a) Rejection

Notwithstanding Examiner's rejection of claims 2-7, 9 and 10 under 35 U.S.C. § 103(a), Applicant respectfully submits that claims 2-7, 9 and 10 are patentable as claims 2-7, 9 and 10 each depend from and incorporate all the limitations of allowable claim 1. As such, Applicant respectfully submits that claims 2-7, 9 and 10 are patentable as depending from allowable claim 1.

**VII. Allowable Subject Matter**

The Examiner stated that claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims. Applicant respectfully brings to the Examiner's attention that the Examiner did not set forth a rejection of claim 8 under 35 U.S.C. § 112 – the Examiner's rejections under 35 U.S.C. § 112 was for claims 3-7, 9, and 10. Claim 8 does not depend from any of these claims 3-7, 9, or 10. While applicant acknowledges the statement of allowable subject matter by the Examiner, Applicant respectfully submits that claim 8 is currently patentable. Claim 8 ultimately depends from claim 1 which, for

Commissioner for Patents  
Serial No.: 10/749,611  
Response Date: December 13, 2005  
Reply to Office Action dated September 22, 2005  
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the reasons set forth above, is believed to be patentable over Fanti and over Fanti and Boba et al. in combination.

### CONCLUSION

For all the foregoing reasons, it is respectfully submitted that the Applicant has made a patentable contribution to the art and that this response places the Application in condition for allowance. Accordingly, favorable reconsideration and allowance of this Application is respectfully requested. In the event the Applicant has inadvertently overlooked the need for a payment of a fee or extension of time, the Applicant conditionally petitions therefor, and authorizes any fee deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

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